



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,590	08/16/2001	Scott G. Newnam	109.779.134	2417
23483 7590 09/12/2007 WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			EXAMINER ALAM, UZMA	
			ART UNIT 2157	PAPER NUMBER
			NOTIFICATION DATE 09/12/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
tina.dougal@wilmerhale.com

Office Action Summary

Application No.

09/931,590

Applicant(s)

NEWNAM ET AL.

Examiner

Uzma Alam

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-19 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-19 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/21/07.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

This action is responsive to the amendment filed on June 21, 2007. Claims 1 and 13 have been amended. Claims 20-27 are cancelled. Claims 28-35 are new. Claims 1-10, 12-19 and 28-35 are pending. Claims 1-10, 12-19 and 28-35 represent an interactive storage device storing broadcasted events.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9, 12, 13, 15-19 and 28-33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Harper et al. US Patent No. 5,537,141. Harper teaches the invention as claimed including an interactive distance learning system (see abstract).

As per claims 1, 13 and 30, Harper teaches a method and system for enhancing a broadcast event for a plurality of remote viewers each having a client device including a local storage device and a personal interactivity recorder (PIR) for storing the broadcast event and playing back the broadcast event, and an interactive television system for storing and playing back an enhanced video program, the method and system comprising:

Each local storage device (first and second storage device, column 17, lines 35-60) receiving and storing the broadcast event as it is being broadcast via a broadcast event signal to

Art Unit: 2157

the plurality of remote viewers during a first time period (column 3, lines 59-67; column 4, lines 1-12; column 5, lines 7-37; column 7, lines 11-24; column 18, lines 23-55);

Each PIR receiving and storing interactive content provided from a server system separately from the broadcast of the broadcast event and not embedded in the broadcast event signal, the interactive content being related to the broadcast event, the same interactive content being configured to be displayed by each client device during the first time period; each PIR temporally associating the interactive content received from the server with the broadcast event (an interactive device storing broadcasted events; column 3, lines 34-67; column 4, lines 1-12; column 5, lines 7-37; column 6, lines 42-57; column 19, lines 21-29);

A particular one of the client devices retrieving the stored broadcast event and interactive content in response to a user command (column 5, lines 7-37); and

the particular one of the client devices playing back the retrieved broadcast event from storage during a second time period such that when the retrieved broadcast event is played back from storage, the corresponding PIR provides to the user the interactive content at one or more times during the stored-retrieved broadcast event when such interactive content would have been displayed when the event was being broadcast, the interactive content provided by the corresponding PIR during the second time period configured to be the same interactive content that would have been displayed when the event was broadcast during the first time period.

(storing interactive responses; column 4, lines 11-57; column 5, lines 46-63; column 11, lines 36-63; column 11, lines 36-63; column 19, lines 55-67; column 20, lines 1-22).

Art Unit: 2157

As per claims 3 and 15, Harper teaches the method and system of claims 1 and 13, wherein the temporal associating includes using one or more of absolute time codes, relative time codes, and frame sequence numbers (the broadcast event is played back using relative sequencing; column 6, lines 20-41; column 7, lines 11-64; column 12, lines 1-25).

As per claims 4 and 16 and 17, Harper teaches the method and system of claims 1 and 13 wherein the interactive content includes trivia questions, the user has an input device for entering an answer, and the PIR stores the correct answer and provides to the user an indication of a correct or incorrect answer after the user enters an answer to a question (the event stores answers to questions during the broadcast; column 6, lines 58-67; column 7, lines 1-10).

As per claims 5 and 18, Harper teaches the method of claims 1 and 13, wherein the interactive content includes poll questions, the PIR storing poll results, the user has an input device for entering a response, and the PIR provides poll results after the user enters a response to the poll question (column 25, lines 18-67; column 26, lines 13-20).

As per claims 6 and 19, Harper teaches the method of claim 1, wherein the interactive content and video broadcast event are stored on the same medium (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

Art Unit: 2157

As per claim 7, Harper teaches the method of claim 1, wherein the PIR uses the processing and storing functionality of the local storage device (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 8, Harper teaches the method of claim 7, wherein the local storage device includes a hard drive (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 9, Harper teaches the method of claim 1, wherein the local storage device includes a hard drive (column 7, lines 11-24; column 6, lines 45-49; column 17, lines 53-67; column 18, lines 1-22, 43-67; column 19, lines 1-20).

As per claim 12, Harper teaches the method of claim 1, wherein the PIR includes processing and storage (column 7, lines 11-24; column 6, lines 45-49).

As per claims 28,29 and 35, Harper teaches the method and system of claims 1, 13 and 30 wherein the interactive content provided by the PIR and at the time of the broadcast event is not targeted interactive content that is based on individualized viewer profile information (column 3, lines 34-67; column 4, lines 1-12; column 5, lines 7-37; column 6, lines 42-57; column 19, lines 21-29).

As per claim 31, Harper teaches the system of claim 30, wherein the first local storage medium is the same as the second local storage medium (column 17, lines 35-60).

As per claim 32, Harper teaches the system of claim 30, wherein the first recording device is the same as the second recording device (column 17, lines 35-60).

As per claim 33, Harper teaches the system of claim 30 further comprising:
a user input device operably coupled to each client device for transmitting a video control message to the first and second recording devices, the first and second recording devices being configured to separately perform a corresponding action on respectively the video program and interactive content in response to the video control message (column 17, lines 35-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically taught or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 14 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harper et al. in view of Dunn et al. US Patent No. 5,517,257. Harper teaches the method and system of claims 1, 13 and 30 including the PIR having the functionality of a VCR and set top box. See claims 1, 13 and 30 and column 7, lines 11-24; column 16, lines 45-49; column 47, lines 36-52. Harper does not expressly teach wherein the local storage device includes

Art Unit: 2157

functionality for fast forward, rewind, and pause functions. Dunn teaches the local storage device includes functionally for fast forward, rewind, and pause functions. See column 5, lines 39-60. However, the concept and advantages of fast forward, rewind and pause functions is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the VCR and set top box function of Harper with fast forward, rewind and pause functions. A person of ordinary skill in the art would have been motivated to do this to allow the user to view the event conveniently.

Claim 10 is rejected under 35 U.S.C. 103(a) as being anticipated by Harper et al. US Patent No. 5,537,141 in view of Bolnick et al. US Patent Publication No. 2002/0023230.

Harper teaches the method of claim 1. Harper does not teach wherein the PIR stores and plays back messages sent by other viewers using a chat functionality during the broadcast event. Bolnick teaches wherein the PIR stores and plays back messages sent by other viewers using a chat functionality during the broadcast event. See paragraph 0034 and claim 12. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the chat functionality of Bolnick with the broadcast event of Harper. A person of ordinary skill in the art would have been motivated to do this to enhance the interactivity of the session between a student and a teacher.

Response to Arguments

1. Applicant's arguments with respect to claims 1-10, 12-19 and 28-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (571) 272-3995. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uzma Alam
Ua
August 30, 2007


ABDULLAH SALAD
PRIMARY EXAMINER